



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,890	07/31/2001	Javier Roscs	60010338-1	2076

7590 11/01/2006
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2178

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/917,890	Applicant(s) ROSES, JAVIER	
	Examiner Adam M. Queler	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-40 is/are pending in the application.
 4a) Of the above claim(s) 1-18 and 32-40 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 19-26 and 28-31 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 02 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 08/18/2006.
2. Claims 1-27 and 29-40 are pending in the case. Claim 19 is and elected, independent claim.

Election/Restrictions

3. Claims 1-17 and 32-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/2/2006.

Claim Rejections - 35 USC § 112

4. **Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding dependent claim(s) 20, the steps of receiving storing and retrieving do not make sense when taken together. If an image was received from the remote device, and then stored, how could it then be retrieved again? For examining purposes only, only the first two steps will be considered. It appears that the last step is merely a repeat of the retrieving step from claim 19 that the claim is intending to narrow.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2178

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 19-26, 28-29, 31, rejected under 35 U.S.C. 102(e) as being anticipated by Sparks et al. (US006167382A).

Regarding independent claim(s) 19, Sparks discloses a list of images which are on the server and therefore stored on the remote device (col. 5, ll. 20-23). Sparks discloses receiving a user selection of one of the images (col. 6, ll. 7-10). Sparks discloses using the at least one image, therefore inherently it must have been retrieved (col. 6, ll. 48-55). Sparks discloses generating a document including the image (col. 5, ll. 24-35).

Sparks teaches receiving text and attributes and generating the document based on the attributes (col. 22, ll. 38-40). Inherently, these fonts have a font property (as shown on Fig. 55).

Regarding dependent claim(s) 20, Sparks discloses receiving the image from the remote device (col. 5, ll. 48-55). Inherently it must be stored somewhere on the client.

Regarding dependent claim(s) 21, Sparks discloses display a list of images with previews and receiving a user selection (col. 6, ll. 27-36, col. 6, ll. 7-10).

Regarding dependent claim(s) 22, Sparks teaches the preview is a low resolution image (col. 6, ll. 27-36).

Regarding dependent claim(s) 23, Sparks teaches retrieving a high resolution version of the image (col. 3, ll. 48-55).

Regarding dependent claim(s) 24, Sparks teaches the generated document includes the high resolution version (col. 3, ll. 48-55).

Art Unit: 2178

Regarding dependent claim(s) 25, Sparks teaches a selection of a template (col. 5, ll. 22-23).

Sparks teaches the document is generated from the template (col. 3, ll. 48-55).

Regarding dependent claim(s) 26, Sparks teaches receiving attributes for an image and generating the document based on those attributes (col. 9, ll. 52-54).

Regarding dependent claim(s) 27, Spark teaches the attributes include cropping (col. 9, ll. 52-54).

Regarding dependent claim(s) 29, Sparks teaches a text attribute can be position.

Regarding dependent claim(s) 31, Sparks teaches the remote device is a web site (col. 2, ll. 50-51).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sparks in view of Applicant's Admitted Prior Art.**

Regarding dependent claim(s) 30, Sparks does not explicitly disclose printing on C paper size.

Applicant admits (as per MPEP 2144.03.C, no traversal of Official Notice of 04/18/2006 is taken as an admission) it was common as well as desirable to be able to print any paper size, including C paper size. It would have been obvious to one of ordinary skill in the art at the time of the invention to use C paper size for these reasons.

Response to Arguments

9. Applicant's arguments filed 08/18/2006 have been fully considered but they are not persuasive.

Applicant alleges the Sparks does not teach receiving text and attributes. However, Sparks teaches receiving text and attributes and generating the document based on the attributes (col. 22, ll. 38-40). Inherently, these fonts have a font property (as shown on Fig. 55).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

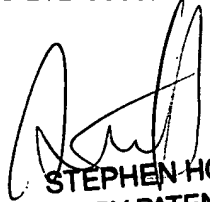
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

Art Unit: 2178

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

aq


STEPHEN HONG
SUPERVISORY PATENT EXAMINER